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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,845	05/23/2001	Herve F. Bouix	2870/296	9937

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NEW YORK, NY 10004

EXAMINER
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MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863,845

Applicant(s)

BOUIX ET AL. 

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 11, and 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected invention as set forth in the previous Office Action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name "Surlyn" cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Nohara (4646925). Barrier teaches a container having a first thin-walled bottle with a neck 2 extending from a storage portion, and a minimum wall thickness, a resin body 5 having a maximum wall thickness at least three times the minimum wall thickness of the storage portion.

Regarding claim 2, the bottle is made from glass (col. 1, lines 51).

Regarding claim 5, the inside body is substantially round as claimed.

Regarding claim 9, note the indicia 3 being formed in the bottle. (col. 1, lines 30).

In the alternative, Nohara teaches that it is known in the art to provide the outer resin outer body by injection molding as shown in Fig. 5. It would have been obvious to one of ordinary skill in the art to provide the outer body by injection molding in Barriere as taught by Nohara to provide an alternative method for making the outer layer.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Barriere rejection, as set forth in paragraph 5, in view of Frye et al. (4138027). Barriere meets all claimed limitations except for the inner bottle being made from aluminum. Frye teaches that it is known

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in the art to make the inner bottle out of aluminum (col. 2, line 64). It would have been obvious to one of ordinary skill in the art to make the inner bottle out of aluminum in Barriere as taught by Frye to provide the desired properties for the inner bottle.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Barriere rejection, as set forth in paragraph 5, in view of Shaffer (3006780). Barriere meets all claimed limitations except for the resin body being square. Shaffer teaches that it is known in the art to provide an outer body being square. It would have been obvious to one of ordinary skill in the art to provide the resin body being square in Barriere as taught by Shaffer to provide added stability.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Barriere rejection, as set forth in paragraph 5, in view of Richie (3738524). Barriere meets all claimed limitations except for the resin body is made from plastics under the trade name "Surlyn" (col. 7, lines 63). Richie teaches that it is known in the art to make a resin body from such plastic. It would have been obvious to one of ordinary skill in the art to make resin body is made from plastics under the trade name "Surlyn" in Barriere as taught by Richie to provide the desired properties.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Barriere rejection, in view of Frye et al., as set forth above, and further in view of Reinhard (3870186). The modified container of Barriere meets all claimed limitations except for the inner bottle being anodized. Reinhard teaches that it is known in the art to anodize the inner surface of a body. It would have been obvious to one of ordinary skill in the art anodize the inner surface of the modified container of Barriere to provide the desired finish.

***Response to Arguments***

11. Applicant's arguments with respect to claims have been considered but they are not persuasive.

Applicant argues that the claimed bottle is made from overmolded about a bottle by **injection molding** while the applied reference does not make from the same method. Please note that claim 1 only requires "a resin body over-molded about the first bottle". Claim 1 does not recite any injection method at all. Applicant goes on explaining the properties, e.g., molecular structures, of the claimed bottle. Likewise, none of these properties are being recited in the claim. The claim only requires a resin, that that is taught by Barriere.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as set forth in the previous Office Action, the patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai  
Primary Examiner  
Art Unit 3727



May 9, 2003